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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/977,407 11/24/97 LU

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EXAMINER

MMC2/0908

TRIAL & TECHNOLOGY LAW GROUP
545 MIDDLEFIELD ROAD SUJITE 220
MENLO PARK CA 94025

MAT. A

ART UNIT

PAPER NUMBER

2832

DATE MAILED:

09/08/00

#12

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/977,407

Applicant(s)
LU et al.

Examiner
Anh Mai

Group Art Unit
2832



☒ Responsive to communication(s) filed on Jul 6, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-7 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-7 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Continued Prosecution Application

1. The request filed on July 6, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/977407 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the claims, what does applicant intend by "carried within"? A package is the device claimed. The transformers can not be carried within the package. They are part of the package.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick on paper "Surface Mount Transformers: A New Packaging Approach" in view of Wilfinger et al. [US 5545841] and Matsumura et al. [US 5034854].

McCormick discloses:

- a one-piece construction package having side wall and an open bottom;
- two toroid transformers positioned inside the package;
- the transformers having wires wrapped thereon;
- a plurality of terminal pins molded within and extending through and below a bottom of the side wall [figures 1, 2].

McCormick discloses the instant claimed invention except for one end of the pins having notched solder and the other end of each pin extending in gull wing fashion outwardly from and below the bottom of the side wall. Matsumura discloses an encased transformer wherein terminal 31 provided with a notch 33 [figure 11c, col 5, lines 30-42] and the other end of the pins extending in gull wing fashion [figure 16]. It would have been obvious to a person of ordinary skill in the art to add notches to one end of the pin and the other end having gull wing shape as taught by Matsumura to McCormick. The motivation would have been to facilitate the mounting of the winding and terminal connection. Therefore, it would have been obvious to combine Matsumura with McCormick.

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Matsumura and McCormick disclose the claimed invention except for a reinforcement beam located along the bottom of the package. Wilfinger discloses a reinforced beam 15 located laterally along the bottom of the package [figure 1] to reinforce the mechanical strength of the package. It would have been obvious to one having ordinary skill in the art at the time the invention was made to add the reinforced beam as taught by Wilfinger to Matsumura and McCormick for the reason stated above.

With respect to claim 7, Matsumura's figure 9 shows the edge of the package as a standoff to keep the distance between the post 31a to PCB 55. It would have been obvious to a person of ordinary skill in the art to have a standoff as taught by Matsumura to McCormick. The motivation would have been to separate the posts from the PBC. Therefore, it would have been obvious to combine Matsumura with McCormick and Wilfinger.

Response to Arguments

4. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh Mai whose telephone number is (703) 308-2900.

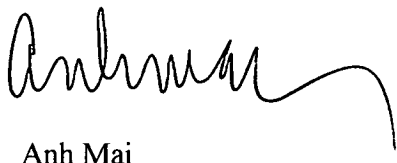
If attempt to reach the examiner by phone unsuccessful, the examiner's supervisor, Michael Gellner, can be reached at (703) 308-1721.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist of the Technology Center whose telephone number is (703) 308-0956. The facsimile numbers for Technology Center 2800 are (703) 305-3432/3431.

A handwritten signature in black ink, appearing to read 'Anh Mai', with a long, sweeping horizontal line extending to the right.

Anh Mai

September 5, 2000